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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,679	02/22/2001	Wyatt Paul	0623.0890000	2280

26111 7590 07/26/2002

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WASHINGTON, DC 20005-3934

EXAMINER

COLLINS, CYNTHIA E

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 07/26/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/646,679

Applicant(s)

PAUL ET AL.

Examiner

Cynthia Collins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02/22/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

**Group I**, claim(s) 1-8, 10-16 and 25-27, drawn to a nucleic acid encoding a signal transduction protein involved in plant dehiscence, a cell or plant, a process for obtaining a cell or plant, and a process for regulating or controlling dehiscence in a plant. For Group I, restriction to a single nucleic acid sequence and the amino acid sequence it encodes is also required under 35 USC 121 and 372. Therefore, if Group I is elected, a single nucleic acid sequence and the amino acid sequence it encodes must also be elected.

**Group II**, claim(s) 9 and 27, drawn to a nucleic acid which is a naturally occurring promoter of a nucleic acid encoding a signal transduction protein. For Group II, restriction to a single nucleic acid sequence is also required under 35 USC 121 and 372. Therefore, if Group II is elected, a single nucleic acid sequence must also be elected.

**Group III**, claim(s) 17-19 and 29, drawn to a signal transduction protein involved in plant dehiscence and use of a signal transduction protein involved in plant dehiscence. For Group III, restriction to a single amino acid sequence is also required under 35 USC

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121 and 372. Therefore, if Group III is elected, a single amino acid sequence must also be elected.

**Group IV**, claim(s) 20-24, drawn to a process for regulating or controlling dehiscence in a plant. For Group IV, restriction to a single nucleic acid sequence and the amino acid sequence it encodes is also required under 35 USC 121 and 372. Therefore, if Group IV is elected, a single nucleic acid sequence and the amino acid sequence it encodes must also be elected.

**Group V**, claim(s) 28, drawn to use of a nucleic acid as a primer. For Group V, restriction to a single nucleic acid sequence is also required under 35 USC 121 and 372. Therefore, if Group V is elected, a single nucleic acid sequence must also be elected.

The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking the inventions of Groups I-V appears to be a nucleic acid encoding a signal transduction protein involved in plant dehiscence. However, a nucleic acid encoding a signal transduction protein involved in plant dehiscence is obvious or anticipated over Nelson et al. (May 1997, Plant Physiology, Vol. 114, No.1, pages 29-37, Applicant's Search Report), and therefore does not constitute a special technical feature as defined by PCT Rule 13.2, because it does not define a contribution over the prior art. Furthermore, the nucleic acids of Groups I and II do not share a common function because the nucleic acids of Group I function to encode a protein and the nucleic acids of Group II function as regulatory sequences that

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control the expression of a nucleic acid. The nucleic acids of Groups I and II and the protein of Group III do not share a common structure, and do not share a common function because the protein of Group III functions to transduce a signal. Additionally, the methods of Groups IV and V employ different products (nucleic acid encoding a polypeptide versus nucleic acid primer) for different uses (polypeptide expression versus primer hybridization).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Remarks***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (703) 605-1210. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

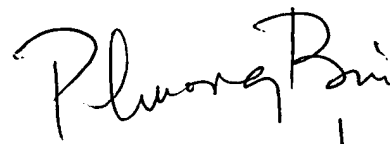
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

CC

July 23, 2002

  
PHUONG T. BUI  
PRIMARY EXAMINER 7/23/02